

**REMARKS**

Claims 1–20 remain in the application. Claim 4 has been amended to simply correct a typographical error. Accordingly, no new matter has been introduced in the present Amendment.

***Claim Objections***

Claim 4 stands objected to because of a typographical error, which has been amended as suggested by the Examiner and as described above. Accordingly, the Applicants believe that this objection is now moot.

***Claim Rejections - 35 USC §112***

Claims 1–20 stand rejected under 35 U.S.C. §112, first paragraph. The instant specification is objected to under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement by failing “to incorporate a foreign test standard in the specification”. Specifically, the Examiner directs the Applicants to a foreign test standard in “the specification (6:17-20 and reference examples 1-3)”. *However*, the Applicants note that the aforementioned reference, i.e., “(6:17-20...)”, refers to a specification of U.S. Patent Application No. 5,945,471 to Morita et al. (the ‘471 patent), not to the instant specification of the present application. The Applicants believe that the Examiner has mistakenly referenced the ‘471 patent rather than the present application, and therefore respectfully traverse this rejection and submit that the instant specification satisfies 35 U.S.C. §112, first paragraph.

Furthermore, for arguments sake, the Applicants respectfully assert that the Examiner has failed to adequately provide a reason why the instant specification would not comply with the enablement requirement. The Examiner has the initial burden of producing reasons that substantiate a rejection based on lack of enablement. See *In re Strahilevitz*, 668 F.2d 1229, 1232, 212 USPQ 561, 563 (C.C.P.A. 1982); *In re Marzocchi*, 439 F.2d 220, 223-24, 169 USPQ 367, 369-70 (C.C.P.A. 1971); and MPEP 2163.04. The Examiner has referenced a foreign test standard; however, the test for compliance with the enablement requirement, as found in the first paragraph of 35 U.S.C. §112, is whether the disclosure, as filed, is sufficiently complete to enable one of ordinary skill in the art to make and use the claimed invention without undue experimentation. See *In re Wands*, 858 F.2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988); *In re Scarbrough*, 500 F.2d 560, 566, 182 USPQ 298, 303 (C.C.P.A. 1974); and MPEP 2164.01

The Applicants direct the Examiner to the instant specification at paragraph [0021], where the present application first introduces a foreign test standard, specifically JIS (Japanese Industrial Standard) A durometer hardness, where “[p]hysical properties of the cured silicone powder (A) are not critical, but the JIS (Japanese Industrial Standard) A durometer hardness preferably should not exceed 90, preferably should be less than 50, when the cured silicone powder is a silicone rubber powder.” (emphasis added). JIS A durometer hardness is further described in paragraph [0067], where “[c]urable silicone compositions, which were used as starting materials for the cured silicone powder (A), were cured in sheet form and their hardness was measured by using a JIS A hardness tester conforming to JIS K 6301.” (emphasis added). In other words, for purposes of the present invention, JIS A durometer

hardness is determined according to JIS K 6301. JIS A durometer hardness is yet further described in paragraphs [0076] and [0077] of the instant specification, and is claimed in claim 15 of the present application.

The Applicants respectfully assert that those of ordinary skill in the silicone art are well aware of various standards, tests, and methods related to determining hardness of materials, including JIS K 6301, as well as other standards, tests, and methods for other physical properties of materials. Therefore, undue experimentation for making and using the present invention would not be required, as hardness of the cured silicone powder (A) can readily be determined by directly following the test as taught and outlined by JIS K 6301. Further, the Applicants note that JIS K 6301 has been previously disclosed in previous U.S. patent applications, including the '471 patent, as are other standards, tests, and methods known to those of ordinary skill in the silicone art regarding hardness of materials, e.g. ASTM D 2240 (Shore A hardness), without the aforementioned patents providing any additional information pertaining to specifics of these standards, tests, and methods themselves. Accordingly, the 35 U.S.C. §112, first paragraph objection should be withdrawn.

***Claim Rejections - 35 USC §103***

Claims 1–6 and 9–20 stand rejected under 35 U.S.C. §103(a) as being obvious over the '471 patent in view of U.S. Patent Application No. 5,387,624 to Morita et al. (the '624 patent). Further, claims 7 and 8 stand rejected under 35 U.S.C. §103(a) as being obvious over the '471 patent in view of the '624 patent. The Applicants respectfully traverse these rejections. To support this traversal, the Applicants refer to the Declaration Under 37 CFR

§1.132, filed herewith. The Declaration has been executed by the second inventor, Kazuo Kobayashi, who is one highly skilled in the art of silicones including silicone powders and methods for producing such silicones including, in particular, methods for producing composite cured silicone powders. In light of the Declaration, and as reinforced below, the Applicants respectfully assert that the Examiner has failed to establish a *prima facie* case of obviousness with regard to independent claims 1 and 7.

To summarize, claim 1 encompasses a composite cured silicone powder. The composite cured silicone powder comprises cured silicone powder (A) that has an average particle size of 0.1 to 500 micrometers, an inorganic fine powder (B) coated on a surface of the cured silicone powder (A), and a surface-active agent (C) coated on a surface of the inorganic fine powder (B). Claim 7 encompasses a method for producing the composite cured silicone powder of claim 1. The method comprises mixing components (A), (B), and (C) under conditions of mechanical shearing.

As the Examiner is well aware, to properly establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. (MPEP §2143). In addition, “[a]ll words in a claim must be considered in judging the patentability of that claim against the prior art.” *In re Wilson*, 424 F.2d 1382, 1385 (C.C.P.A. 1970).

Existing precedent provides guidance for establishing a motivation to modify a reference or references. In particular, “[t]he motivation to modify the prior art must flow from some teaching in the art that suggests the desirability or incentive to make the modification needed to arrive at the claimed invention.” *Alza Corp. v. Mylan Laboratories Inc.*, 391 F.3d 1365 (Fed. Cir. 2004). The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. See MPEP 2143.01(III.), citing *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). The Examiner is also reminded that “[c]are must be taken to avoid hindsight reconstruction by using the patent in suit as a guide through the maze of prior art references, combining the right references in the right way so as to achieve the result of the claims in suit.” *Grain Processing Corp. v. American Maize-Prods. Co.*, 840 F.2d 902 (Fed. Cir. 1998).

In the instant office action, the Examiner appropriately recognizes that the ‘471 patent does not explicitly teach a surface-active agent (C) which is coated on the inorganic fine powder (B), as is taught and claimed in the present application, and as described in paragraph 4 of the Declaration. The Examiner then suggests that the ‘471 and ‘624 patents are “combinable because they are concerned with a similar technical difficulty, namely, the preparation of cured silicone powders”. *However*, as illustrated in paragraphs 6-9 of the Declaration, the Applicants assert that even if the references were to be combined, the references combined still fail to teach or suggest all of the claim limitations of the present

application. Accordingly, no *prima facie* case of obviousness can be established with respect to independent claims 1 and 7.

The '624 patent discloses a method for the preparation of a powder mixture that is composed of cured silicone microparticles and inorganic microparticles. "In the preparative method according to the present invention, a surfactant (C) is preferably added during preparation of the water-based emulsion of the curable liquid silicone composition since this imparts an excellent stability to the water-based emulsion of the curable liquid silicone composition and also makes possible smaller particle sizes for the curable liquid silicone composition in the emulsion." Column 3, line 66+ of the '624 patent (emphasis added). In other words, the surfactant (C) of the '624 patent is added during preparation of the cured silicone microparticles, to adjust particle sizes of the cured silicone microparticles while in liquid form, i.e., while in the water-based emulsion. More specifically, as described in paragraph 8 of the Declaration, the surfactant (C) of the '624 patent is not a separate component added distinctively/separately during preparation of the resulting powder mixture of the '624 patent itself, *instead*, the surfactant is merely used to prepare the cured silicone microparticles. As such, the '624 patent does not teach or suggest coating the inorganic microparticles with its surfactant. *Conversely*, as taught and claimed in the present application, the surface-active agent (C) is added to the cured silicone powder (A) and the inorganic fine powder (B) to coat the inorganic fine powder (B) and to impart hydrophilic properties thereto.

As described in paragraph 8 of the Declaration, the Applicants recognize that the cured silicone powders (A) of the present invention can be prepared in the same manner as described above with the cured silicone microparticles of the '624 patent, specifically by employing surfactants/surface-active agents. Referring to the instant specification, "the cured silicone powders (A) can be prepared by...dispersing them in water or aqueous dispersions of surface active agents." Paragraph [0029] (emphasis added). "Among the methods used for preparing the aforementioned cured silicone powders (A), the method in which these curable silicone compositions are cured by dispersing them in water or aqueous dispersions of surface active agents is particularly preferable from the standpoint that it results in the formation of spherical cured silicone powders of superior dispersibility in aqueous compositions." Paragraph [0033] (emphasis added). "Also, in order to stabilize these curable silicone compositions in terms of particle shape, it is preferable to use aqueous dispersions of surface-active agents in water-based systems. Paragraph [0035] (emphasis added). *However*, as described in the instant specification, "[t]hese surface-active agents are additional component [sic] and different from "surface-active agents (C)"..." Paragraph [0035] (emphasis added). Further, as described in paragraphs 7 and 8 of the Declaration, neither the '471 patent nor the '624 patent teach or suggest the desirability of combining distinct surface-active agents/surfactants and the inorganic fine powder (B). If anything, the '624 patent only suggests the desirability of combining the surfactant (C) with the curable liquid silicone composition during preparation thereof, as described above, and as similarly

taught and described in the instant specification with regard to preparing the cured silicone powders (A).

As noted in the Background Art section of the present application, the Applicants are aware of previous composite cured silicone powders, such as the powder mixture of the '624 patent. However, as described in the instant specification, "[c]omposite cured silicone powders with adherence of the inorganic fine powder to the surfaces of the composite powders and with improved flowability have been proposed... [t]hese composite cured silicone powders, however, exhibit poor hydrophilicity..." Paragraph [0004] (emphasis added). As already described above, the surface-active agent (C) is coated on the surface of the inorganic fine powder (B), as taught and claimed in the present application. "The surface-active agent (C), which in the composite cured silicone powder is present on the surfaces of the inorganic fine powder particles, is a component that improves hydrophilic properties of the composite cured silicone powder." Paragraph [0047] (emphasis added).

*On the contrary*, as alluded to in paragraph 9 of the Declaration, the '624 patent does not teach or suggest any desirability with regard to combining the surfactant (C) with the inorganic microparticles, or even with the resulting cured silicone microparticles, *after* preparation of the inorganic microparticles (which is in powder form) or the resulting powder mixture of the '624 patent itself. Further, neither the '471 patent nor the '624 patent teach or suggest that surfactants/surface-active agents can be used for improving hydrophilic properties of any one component disclosed, *let alone* be used for improving hydrophilic properties of their resulting composite powder compositions and powder mixtures. If



anything, the '471 patent only teaches the opposite of *hydrophilic*, that “micropowders obtained by subjecting the surface of these inorganic micropowders to *hydrophobic* treatment with organoalkoxysilane, organochlorosilane, organosilazane and other organosilicon compounds can also be used.” Column 5, lines 32-36 of the '471 patent (emphasis added). In view of the foregoing, the Applicants respectfully submit that claims 1 and 7 are both novel and non-obvious.

Furthermore, even if for argument's sake, one assumes the '471 and '624 patents are combined, the third criteria of a *prima facie* case of obviousness is still not established. With regard to claim 1, as described in paragraphs 7-9 of the Declaration, and as described above, there is no teaching or suggestion in the '471 patent or the '624 patent, either independently or when combined, that the surface-active agent (C) is coated on the surface of the inorganic fine powder (B). Likewise, with regard to claim 7, there is no teaching or suggestion in the '471 patent or the '624 patent, either independently or when combined, of the claimed step of mixing the surface-active agent (C) with the cured silicone powder (A) and the inorganic fine powder (B) *after* prior formation of the cured silicone powder (A). If anything, the '471 and '624 patents, when combined, only teach an equivalent step of mixing: 1) the cured silicone powder (A) (which is first prepared using a surfactant different from the surface-active agent (C) of the present application), and 2) the inorganic fine powder (B) of the present application.

In view of the foregoing, and further in view of the statements contained in the referenced Declaration, the Applicants respectfully submit that claims 1 and 7 are both novel

and non-obvious, in view of the disclosure, teachings, and suggestions of the prior art such that claims 1 and 7, as well as the claims that depend therefrom, are in condition for allowance.

If any additional fees are necessary to respond to the outstanding Office Action, you are hereby authorized to charge such fees to Deposit Account No. 08-2789 in the name of Howard & Howard.

**Respectfully submitted,**

**HOWARD & HOWARD ATTORNEYS**

October 19, 2007

Date

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